REMARKS

Claim 23 is amended to further define and clarify the features of the invention. Claims 44 and 45 (renumbered as claims 43 and 44) stand withdrawn and claim 33 (renumbered as claim 32) is cancelled. No new matter is added by virtue of the within amendments; support therefor can be found throughout the specification and in the original claims.

Claim 33 is objected to under 37 CFR 1.75(c) for failing to further limit the subject matter of a previous claim (claim 23). Claim 33 (renumbered as claim 32) is cancelled, thus rectifying this informality.

Further objection is made to the claims in that claim 32 was missing from the claim set introduced by a preliminary amendment filed with the original application papers on January 5, 2005. Each of the affected claims has been renumbered, thus rectifying this informality.

Claim 30 stands rejected under 35 USC §112, 2nd paragraph, for lack of antecedent basis. Claim 30 has been amended to depend from claim 29, thus rectifying this informality.

Claims 23-31, 34-37 and 41-43 stand rejected under 35 USC §103(a) over Lossing et al. (US 6,528,248) in view of Bova (US 2002/0025511) and Baer (US2001/0028934).

The rejection is traversed. Even in combination, the cited references fail to teach or suggest the features of the invention. Moreover, without acquiescing to the grounds for the rejection, independent claim 23 has been amended to further define and clarify the distinctive features of the present invention.

The present invention relates to a process for preparing a biological material for examination with a microscope in a laser microscope system, for example a laser micro dissection system, whereby the visual characteristics of the

biological material are improved by application of a UV laser light absorbing transparent film onto the surface of the biological material such that irregularities on the surface of the biological material are smoothed out, so that the biological material can be examined better with a microscope. In order to permit use of a biological material having been prepared in this matter in a laser microdissection system, the transparent film comprises UV laser light absorbing material, so that the UV laser light beam of the laser micro dissection system is completely absorbed by this film and can be cut efficiently together with the biological material, so that, for example, a portion of the biological material can be completely separated together with a corresponding portion of the laser light absorbing film from the surrounding biological material or can be catapulted from the biological material to a receptacle.

Consequently, it is an important feature of present invention, that the transparent film applied to the surface of the biological material be a UV laser light absorbing film which, when applied to the biological material, can be cut together with the biological material with the aid of a UV laser light beam.

Lossing et al. disclose a method for preparing a biological material for carrying out a so-called LCM process ("laser capture microdissection"). Lossing applies a transparent film to the surface of the biological material (see Lossing's abstract in combination with column 1, lines 51-64 and column 3, line 59 – column 4, line 28).

Contrary to the features of amended independent claim 23, Lossing et al. do not teach or suggest that the transparent film is applied to the surface of the biological material in order to smooth out irregularities on the surface of the biological material.

Furthermore, Lossing et al. do not teach or suggest that the transparent film applied to the surface of the biological material is a UV laser light absorbing film. Indeed, that is expressly acknowledged in the Office Action.

Neither Bova (US 2002/0025511) nor Baer et al. (US 2001/0028934) remedy the deficiencies of Lossing et al.

Even in combination, these references fail to teach or suggest the features of amended independent claim 23 according to which the transparent film is a UV laser light absorbing film which is applied to the surface of a biological material such that it can be cut together with the biological material with the aid of a UV laser light beam.

Bova only discusses the consequences of the irradiation of a tissue with UV laser light. In particular, Bova proposes to selectively irradiate tissue with UV light in order to selectively ablate and, therefore, destroy the corresponding portion of the biological material (see the abstract and paragraphs [0011] and [0026] of Bova).

Baer at al. disclose an LCM process whereby, according to Fig. 2, an adhesive layer 114 with UV curable adhesives is used, so that, by means of irradiation with UV light, the adhesive layer 114 can adhere to the biological material so as to remove the corresponding portion of the biological material together with the adhesive layer (see paragraphs [0004] and [0043] of Baer at al. in combination with Fig. 2). Contrary to the features of the invention recited in amended claim 23, the UV laser light absorbing film is not applied to the surface of the biological material in order to smooth out irregularities on the surface of the biological material and improve the visual characteristics of the biological material. Instead, the adhesive layer 114 of Baer et al. serves a completely different purpose, namely it is provided to efficiently melt the transfer film 100 comprising the adhesive layer 114 onto the biological material 118.

Even in combination, Lossing, Bova and Baer are insufficient to sustain the rejection. These documents do not teach or suggest a UV laser light absorbing film which is applied onto the surface of a biological material in order to facilitate cutting the UV laser light absorbing film together with the biological material by means of UV laser light irradiation.

Accordingly, the rejection is properly withdrawn. For example, see *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978) ("[r]ejections under 35 U.S.C. §102 are proper only when the claimed subject matter is identically disclosed or described in the prior art.") Additionally, it is well-known that to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference(s) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaec*k, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143.

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the cited references to make the claimed invention, nor is there a reasonable expectation of success.

In view of the above amendments and remarks, Applicant believes the pending application is in condition for allowance.

FEE AUTHORIZATION

No fees are believed to be due. However, should any fees be asserted, the Commissioner is authorized to charge such fees (or credit any overpayment) to Deposit Account No. 04-1105, Reference No. 62514(45107).

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Respectfully submitted,

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